

REMARKS

In the specification, paragraph [0028] has been amended.

Claims 1-24 were originally filed in the present application. No claims are currently canceled, and new claims 25 and 26 are currently added. Accordingly, claims 1-26 are currently pending in the present application.

Reconsideration of this application in light of the above amendments and the following remarks is requested.

Drawing Objections

The Examiner has objected to the drawings because they do not include the reference number "30" which is mentioned in the originally-filed application. However, the specification of the present application (specifically, paragraph [0028]) is currently amended to delete this reference number 30. Accordingly, Applicants respectfully request the Examiner withdraw the objection to the drawings.

Rejections Under 35 U.S.C. §103: Mihalko in view of Lindquist

Claim 1

Claim 1 recites

1. An electric motor for use in a surgical procedure, comprising:
a motor output member;
a driven member coupled to the motor output member; and
a driving member having a winding and a magnetic portion disposed proximate the driven member such that energizing the driving member imparts motion to the driven member, wherein the magnetic portion comprises a nanocrystalline alloy characterized by nanoscale grains consuming between about 70% and about 80% of the nanocrystalline alloy, by volume.

Claim 1 was rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,937,485 to Mihalko ("Mihalko") in view of U.S. Patent No. 6,737,784 to Lindquist, et al. ("Lindquist"). Applicants traverse this rejection on the grounds that these references are defective in establishing a *prima facie* case of obviousness with respect to claim 1.

As the PTO recognizes in MPEP §2142:

... The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the Examiner does not produce a prima facie case, the Applicant is under no obligation to submit evidence of nonobviousness...

It is submitted that, in the present case, the Examiner cannot factually support a *prima facie* case of obviousness of claim 1 for the following mutually exclusive reasons.

1. Even when combined, the references do not teach the claimed subject matter

As provided in 35 U.S.C. §103:

A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, neither Mihalko nor Lindquist teaches an electric motor having magnetic portion comprising a nanocrystalline alloy characterized by nanoscale grains consuming between about 70% and about 80% of the nanocrystalline alloy, by volume, as recited in claim 1. That is, the Examiner concedes that Mihalko fails to teach a magnetic portion comprising any nanocrystalline alloy whatsoever. (Examiner's Office Action, page 4, lines 7-9). Moreover, Lindquist merely teaches that a magnetic portion can comprise a nanocrystalline alloy characterized by the presence of grains averaging in size from 10 nm to 100 nm and occupying at least 50% of the volume of the alloy (column 9, lines 40-48), in contrast to such grains occupying between about 70% and about 80% of the alloy volume, as recited in claim 1 of the present application.

Applicants also note that Lindquist further discloses that amorphous metal alloys that are suitable for use as feedstock can be formed with a substantially fully glass microstructure, wherein at least about 80% by volume of the material has a non-crystalline structure. (Lindquist, column 8, lines 61-67). However, such disclosure is only applicable to feedstock, in contrast to the finished product. That is, Lindquist further provides that such feedstock is formed into the requisite geometrical shape of a finished

stator while still in its as-cast, ductile, substantially non-crystalline form, such that a nanocrystalline structure is formed only after heat treatment is subsequently performed on the feedstock. (Lindquist, column 9, line 52 – column 10, line 3).

In view of the above, neither Mihalko nor Lindquist teaches a nanocrystalline alloy characterized by nanoscale grains consuming between about 70% and about 80% of the nanocrystalline alloy, by volume, as recited in claim 1. Consequently, it is impossible for the combination of Mihalko and Lindquist to render obvious the subject matter of claim 1, as a whole, and the explicit terms of 35 U.S.C. §103(a) cannot be met. Thus, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met by the combination of Mihalko and Lindquist with respect to claim 1, and the rejection of claim 1 under 35 U.S.C. §103(a) should be withdrawn.

2. The combination of references is improper

Another mutually exclusive and compelling reason why Mihalko and Lindquist cannot be applied to reject claim 1 under 35 U.S.C. §103(a) regards MPEP §2142:

...the Examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made.....The Examiner must put aside knowledge of the Applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.

Here, neither Mihalko nor Lindquist teaches or even suggests the desirability of combination to arrive at the recitation of claim 1 of the present application, since neither teaches a nanocrystalline alloy characterized by nanoscale grains consuming between about 70% and about 80% of the nanocrystalline alloy, by volume, as specified above and as recited in claim 1. Thus, it is clear that neither reference provides any incentive or motivation supporting the desirability of their combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of claim 1.

In this context, the MPEP further provides at §2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In the above context, the courts have repeatedly held that, absent some teaching, suggestion or incentive supporting combination, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention. In the present case, it is clear that the Examiner's combination can arise solely from hindsight based on the present application, because there exists no showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 1. Therefore, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met by the combination of Mihalko and Lindquist with respect to claim 1, and the rejection of claim 1 under 35 U.S.C. §103(a) should be withdrawn.

Claim 14

Claim 14 recites

14. An electric motor, comprising:
an output shaft;
a rotor coupled to the output shaft; and
a stator having a winding and a magnetic portion disposed about the rotor such that energizing the stator imparts rotary motion to the rotor, wherein the magnetic portion comprises a nanocrystalline alloy characterized by grains ranging in size from about 10 nm to about 25 nm and consuming between about 70% and about 80% of the nanocrystalline alloy, by volume, wherein the grains are homogeneously dispersed in an amorphous matrix.

Claim 14 was also rejected under 35 U.S.C. §103(a) as being unpatentable over Mihalko in view of Lindquist. Applicants traverse this rejection on the grounds that these references are also defective in establishing a *prima facie* case of obviousness with respect to claim 14, for the following mutually exclusive reasons.

1. Even when combined, the references do not teach the claimed subject matter

As described above, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, neither Mihalko nor Lindquist teaches an electric motor stator having magnetic portion comprising a nanocrystalline alloy characterized by grains ranging in size from about 10 nm to about 25 nm and consuming between about 70% and about 80% of the nanocrystalline alloy, by volume, wherein the grains are homogeneously dispersed in an amorphous matrix, as recited in claim 14. That is, the Examiner concedes that Mihalko fails to teach a magnetic portion comprising any nanocrystalline alloy whatsoever. (Examiner's Office Action, page 4, lines 7-9). Moreover, Lindquist merely teaches that a magnetic portion can comprise a nanocrystalline alloy characterized by the presence of grains averaging in size from 10 nm to 100 nm and occupying at least 50% of the volume of the alloy (column 9, lines 40-48), in contrast to such grains occupying between about 70% and about 80% of the alloy volume and being homogeneously dispersed in an amorphous matrix, as recited in claim 14 of the present application.

Because neither Mihalko nor Lindquist teaches a nanocrystalline alloy characterized by grains ranging in size from about 10 nm to about 25 nm and consuming between about 70% and about 80% of the nanocrystalline alloy, by volume, wherein the grains are homogeneously dispersed in an amorphous matrix, as recited in claim 14, it is impossible for the combination of Mihalko and Lindquist to render obvious the subject matter of claim 14, as a whole, and the explicit terms of 35 U.S.C. §103(a) cannot be met. Thus, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met by the combination of Mihalko and Lindquist with respect to claim 14, and the rejection of claim 14 under 35 U.S.C. §103(a) should be withdrawn.

2. The combination of references is improper

Another mutually exclusive and compelling reason why Mihalko and Lindquist cannot be applied to reject claim 14 under 35 U.S.C. §103(a) is that neither Mihalko nor Lindquist teaches or even suggests the desirability of combination to arrive at the recitation of claim 14 of the present application since neither teaches a nanocrystalline alloy characterized by grains ranging in size from about 10 nm to about 25 nm and consuming between about 70% and about 80% of the nanocrystalline alloy, by volume, wherein the

grains are homogeneously dispersed in an amorphous matrix, as specified above and as recited in claim 14. Thus, it is clear that neither reference provides any incentive or motivation supporting the desirability of their combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of claim 14.

In this context, the courts have repeatedly held that, absent some teaching, suggestion or incentive supporting combination, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention. In the present case, it is clear that the Examiner's combination can arise solely from hindsight based on the present application, because there exists no showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 14. Therefore, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met by the combination of Mihalko and Lindquist with respect to claim 14, and the rejection of claim 14 under 35 U.S.C. §103(a) should be withdrawn.

Claim 16

Claim 16 recites

16. An electric motor, comprising:
a stator having:
 a winding; and
 a magnetic portion comprising a nanocrystalline alloy
 characterized by grains ranging in size from about 10 nm to about
 25 nm and consuming between about 70% and about 80% of the
 nanocrystalline alloy, by volume, wherein the grains are
 homogeneously dispersed in an amorphous matrix; and
 a rotor disposed about the stator such that energizing the stator
 imparts rotary motion to the rotor.

Claim 16 was also rejected under 35 U.S.C. §103(a) as being unpatentable over Mihalko in view of Lindquist. Applicants traverse this rejection on the grounds that these references are also defective in establishing a *prima facie* case of obviousness with respect to claim 16, for the following mutually exclusive reasons.

1. Even when combined, the references do not teach the claimed subject matter

As described above, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, neither Mihalko nor Lindquist teaches an electric motor stator having magnetic portion comprising a nanocrystalline alloy characterized by grains ranging in size from about 10 nm to about 25 nm and consuming between about 70% and about 80% of the nanocrystalline alloy, by volume, wherein the grains are homogeneously dispersed in an amorphous matrix, as recited in claim 16. That is, the Examiner concedes that Mihalko fails to teach a magnetic portion comprising any nanocrystalline alloy whatsoever. (Examiner's Office Action, page 4, lines 7-9). Moreover, Lindquist merely teaches that a magnetic portion can comprise a nanocrystalline alloy characterized by the presence of grains averaging in size from 10 nm to 100 nm and occupying at least 50% of the volume of the alloy (column 9, lines 40-48), in contrast to such grains occupying between about 70% and about 80% of the alloy volume and being homogeneously dispersed in an amorphous matrix, as recited in claim 16 of the present application.

Because neither Mihalko nor Lindquist teaches a nanocrystalline alloy characterized by grains ranging in size from about 10 nm to about 25 nm and consuming between about 70% and about 80% of the nanocrystalline alloy, by volume, wherein the grains are homogeneously dispersed in an amorphous matrix, as recited in claim 16, it is impossible for the combination of Mihalko and Lindquist to render obvious the subject matter of claim 16, as a whole, and the explicit terms of 35 U.S.C. §103(a) cannot be met. Thus, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met by the combination of Mihalko and Lindquist with respect to claim 16, and the rejection of claim 16 under 35 U.S.C. §103(a) should be withdrawn.

2. The combination of references is improper

Another mutually exclusive and compelling reason why Mihalko and Lindquist cannot be applied to reject claim 16 under 35 U.S.C. §103(a) is that neither Mihalko nor Lindquist teaches or even suggests the desirability of combination to arrive at the recitation of claim 16 of the present application since neither teaches a nanocrystalline alloy characterized by grains ranging in size from about 10 nm to about 25 nm and consuming between about 70% and about 80% of the nanocrystalline alloy, by volume, wherein the grains are homogeneously dispersed in an amorphous matrix, as specified above and as recited in claim 16. Thus, it is clear that neither reference provides any incentive or motivation supporting the desirability of

their combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of claim 16.

In this context, the courts have repeatedly held that, absent some teaching, suggestion or incentive supporting combination, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention. In the present case, it is clear that the Examiner's combination can arise solely from hindsight based on the present application, because there exists no showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 16. Therefore, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met by the combination of Mihalko and Lindquist with respect to claim 16, and the rejection of claim 16 under 35 U.S.C. §103(a) should be withdrawn.

Claim 17

Claim 17 recites

17. An electric linear motor, comprising:
a linearly displaceable actuator;
at least one magnetic component coupled to the actuator; and
a stator having a substantially planar winding and a magnetic portion disposed proximate the at least one magnetic component such that energizing the winding imparts linear motion to the actuator, wherein the magnetic portion comprises a nanocrystalline alloy characterized by nanoscale grains consuming between about 70% and about 80% of the nanocrystalline alloy, by volume.

Claim 17 was also rejected under 35 U.S.C. §103(a) as being unpatentable over Mihalko in view of Lindquist. Applicants traverse this rejection on the grounds that these references are also defective in establishing a *prima facie* case of obviousness with respect to claim 17, for the following mutually exclusive reasons.

1. Even when combined, the references do not teach the claimed subject matter

As described above, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, neither Mihalko nor Lindquist teaches an electric linear motor stator having magnetic portion comprising a nanocrystalline alloy characterized by nanoscale grains consuming

between about 70% and about 80% of the nanocrystalline alloy, by volume, as recited in claim 17. That is, the Examiner concedes that Mihalko fails to teach a magnetic portion comprising any nanocrystalline alloy whatsoever. (Examiner's Office Action, page 4, lines 7-9). Moreover, Lindquist merely teaches that a magnetic portion can comprise a nanocrystalline alloy characterized by the presence of grains averaging in size from 10 nm to 100 nm and occupying at least 50% of the volume of the alloy (column 9, lines 40-48), in contrast to such grains occupying between about 70% and about 80% of the alloy volume, as recited in claim 17 of the present application.

Because neither Mihalko nor Lindquist teaches a nanocrystalline alloy characterized by nanoscale grains consuming between about 70% and about 80% of the nanocrystalline alloy, by volume, as recited in claim 17, it is impossible for the combination of Mihalko and Lindquist to render obvious the subject matter of claim 17, as a whole, and the explicit terms of 35 U.S.C. §103(a) cannot be met. Thus, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met by the combination of Mihalko and Lindquist with respect to claim 17, and the rejection of claim 17 under 35 U.S.C. §103(a) should be withdrawn.

2. The combination of references is improper

Another mutually exclusive and compelling reason why Mihalko and Lindquist cannot be applied to reject claim 17 under 35 U.S.C. §103(a) is that neither Mihalko nor Lindquist teaches or even suggests the desirability of combination to arrive at the recitation of claim 17 of the present application since neither teaches a nanocrystalline alloy characterized by nanoscale grains consuming between about 70% and about 80% of the nanocrystalline alloy, by volume, as specified above and as recited in claim 17. Thus, it is clear that neither reference provides any incentive or motivation supporting the desirability of their combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of claim 17.

In this context, the courts have repeatedly held that, absent some teaching, suggestion or incentive supporting combination, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention. In the present case, it is clear that the Examiner's combination can arise solely from hindsight based on the present application, because there exists no showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 17. Therefore, for this

mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met by the combination of Mihalko and Lindquist with respect to claim 17, and the rejection of claim 17 under 35 U.S.C. §103(a) should be withdrawn.

Claim 18

Claim 18 recites

18. An electric motor, comprising:
an output shaft;
a substantially disc-shaped rotor coupled to the output shaft and including a plurality of magnetic components collectively forming a disc-shaped annulus; and
a substantially disc-shaped stator having a winding and a magnetic portion disposed proximate the plurality of magnetic components such that energizing the stator imparts rotary motion to the rotor, wherein the magnetic portion comprises a nanocrystalline alloy characterized by nanoscale grains consuming between about 70% and about 80% of the nanocrystalline alloy, by volume.

Claim 18 was also rejected under 35 U.S.C. §103(a) as being unpatentable over Mihalko in view of Lindquist. Applicants traverse this rejection on the grounds that these references are also defective in establishing a *prima facie* case of obviousness with respect to claim 18, for the following mutually exclusive reasons.

1. Even when combined, the references do not teach the claimed subject matter

As described above, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, neither Mihalko nor Lindquist teaches a substantially disc-shaped stator of an electric motor, the stator having a magnetic portion comprising a nanocrystalline alloy characterized by nanoscale grains consuming between about 70% and about 80% of the nanocrystalline alloy, by volume, as recited in claim 18. That is, the Examiner concedes that Mihalko fails to teach a magnetic portion comprising any nanocrystalline alloy whatsoever. (Examiner's Office Action, page 4, lines 7-9). Moreover, Lindquist merely teaches that a magnetic portion can comprise a nanocrystalline alloy characterized by the presence of grains averaging in size from 10 nm to 100 nm and occupying at

least 50% of the volume of the alloy (column 9, lines 40-48), in contrast to such grains occupying between about 70% and about 80% of the alloy volume, as recited in claim 18 of the present application.

Because neither Mihalko nor Lindquist teaches a nanocrystalline alloy characterized by nanoscale grains consuming between about 70% and about 80% of the nanocrystalline alloy, by volume, as recited in claim 18, it is impossible for the combination of Mihalko and Lindquist to render obvious the subject matter of claim 18, as a whole, and the explicit terms of 35 U.S.C. §103(a) cannot be met. Thus, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met by the combination of Mihalko and Lindquist with respect to claim 18, and the rejection of claim 18 under 35 U.S.C. §103(a) should be withdrawn.

2. The combination of references is improper

Another mutually exclusive and compelling reason why Mihalko and Lindquist cannot be applied to reject claim 18 under 35 U.S.C. §103(a) is that neither Mihalko nor Lindquist teaches or even suggests the desirability of combination to arrive at the recitation of claim 18 of the present application since neither teaches a nanocrystalline alloy characterized by nanoscale grains consuming between about 70% and about 80% of the nanocrystalline alloy, by volume, as specified above and as recited in claim 18. Thus, it is clear that neither reference provides any incentive or motivation supporting the desirability of their combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of claim 18.

In this context, the courts have repeatedly held that, absent some teaching, suggestion or incentive supporting combination, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention. In the present case, it is clear that the Examiner's combination can arise solely from hindsight based on the present application, because there exists no showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 18. Therefore, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met by the combination of Mihalko and Lindquist with respect to claim 18, and the rejection of claim 18 under 35 U.S.C. §103(a) should be withdrawn.

Claim 19

Claim 19 recites

19. A surgical instrument, comprising:
a housing;
an electrical power source;
an output shaft extending from the housing;
a rotor coupled to the output shaft; and
a stator having:
 a winding selectively connectable to the electrical power
 source; and
 a magnetic portion disposed about the rotor and comprising a
 nanocrystalline alloy characterized by grains ranging in size from
 about 10 nm to about 25 nm and consuming between about 70%
 and about 80% of the nanocrystalline alloy, by volume, wherein
 the grains are homogeneously dispersed in an amorphous matrix;
 wherein selectively connecting the electrical power source and the
 stator imparts rotary motion to the output shaft via the rotor.

Claim 19 was also rejected under 35 U.S.C. §103(a) as being unpatentable over Mihalko in view of Lindquist. Applicants traverse this rejection on the grounds that these references are also defective in establishing a *prima facie* case of obviousness with respect to claim 19, for the following mutually exclusive reasons.

1. Even when combined, the references do not teach the claimed subject matter

As described above, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, neither Mihalko nor Lindquist teaches a surgical instrument having a stator, the stator including a magnetic portion comprising a nanocrystalline alloy characterized by grains ranging in size from about 10 nm to about 25 nm and consuming between about 70% and about 80% of the nanocrystalline alloy, by volume, wherein the grains are homogeneously dispersed in an amorphous matrix, as recited in claim 19. That is, the Examiner concedes that Mihalko fails to teach a magnetic portion comprising any nanocrystalline alloy whatsoever. (Examiner's Office Action, page 4, lines 7-9). Moreover, Lindquist merely teaches that a magnetic portion can comprise a nanocrystalline alloy characterized by the presence of grains averaging in size from 10 nm to 100 nm and occupying at least 50% of the volume of the alloy (column 9, lines 40-48), in contrast to such grains occupying between

about 70% and about 80% of the alloy volume and being homogeneously dispersed in an amorphous matrix, as recited in claim 19 of the present application.

Because neither Mihalko nor Lindquist teaches a nanocrystalline alloy characterized by grains ranging in size from about 10 nm to about 25 nm and consuming between about 70% and about 80% of the nanocrystalline alloy, by volume, wherein the grains are homogeneously dispersed in an amorphous matrix, as recited in claim 19, it is impossible for the combination of Mihalko and Lindquist to render obvious the subject matter of claim 19, as a whole, and the explicit terms of 35 U.S.C. §103(a) cannot be met. Thus, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met by the combination of Mihalko and Lindquist with respect to claim 19, and the rejection of claim 19 under 35 U.S.C. §103(a) should be withdrawn.

2. The combination of references is improper

Another mutually exclusive and compelling reason why Mihalko and Lindquist cannot be applied to reject claim 19 under 35 U.S.C. §103(a) is that neither Mihalko nor Lindquist teaches or even suggests the desirability of combination to arrive at the recitation of claim 19 of the present application since neither teaches a nanocrystalline alloy characterized by grains ranging in size from about 10 nm to about 25 nm and consuming between about 70% and about 80% of the nanocrystalline alloy, by volume, wherein the grains are homogeneously dispersed in an amorphous matrix, as specified above and as recited in claim 19. Thus, it is clear that neither reference provides any incentive or motivation supporting the desirability of their combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of claim 19.

In this context, the courts have repeatedly held that, absent some teaching, suggestion or incentive supporting combination, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention. In the present case, it is clear that the Examiner's combination can arise solely from hindsight based on the present application, because there exists no showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 19. Therefore, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met by the combination of Mihalko and Lindquist with respect to claim 19, and the rejection of claim 19 under 35 U.S.C. §103(a) should be withdrawn.

Rejections Under 35 U.S.C. §103: Philipp in view of Lindquist

Claim 19

Claim 19 was also rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,093,593 to Philipp (“Philipp”) in view of Lindquist. Applicants traverse this rejection on the grounds that these references are also defective in establishing a *prima facie* case of obviousness with respect to claim 19, for the following mutually exclusive reasons.

1. Even when combined, the references do not teach the claimed subject matter

As described above, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, neither Philipp nor Lindquist teaches a surgical instrument having a stator, the stator including a magnetic portion comprising a nanocrystalline alloy characterized by grains ranging in size from about 10 nm to about 25 nm and consuming between about 70% and about 80% of the nanocrystalline alloy, by volume, wherein the grains are homogeneously dispersed in an amorphous matrix, as recited in claim 19. That is, the Examiner concedes that Philipp fails to teach a magnetic portion comprising any nanocrystalline alloy whatsoever. (Examiner’s Office Action, page 5, lines 13-14). Moreover, Lindquist merely teaches that a magnetic portion can comprise a nanocrystalline alloy characterized by the presence of grains averaging in size from 10 nm to 100 nm and occupying at least 50% of the volume of the alloy (column 9, lines 40-48), in contrast to such grains occupying between about 70% and about 80% of the alloy volume and being homogeneously dispersed in an amorphous matrix, as recited in claim 19 of the present application.

Because neither Philipp nor Lindquist teaches a nanocrystalline alloy characterized by grains ranging in size from about 10 nm to about 25 nm and consuming between about 70% and about 80% of the nanocrystalline alloy, by volume, wherein the grains are homogeneously dispersed in an amorphous matrix, as recited in claim 19, it is impossible for the combination of Philipp and Lindquist to render obvious the subject matter of claim 19, as a whole, and the explicit terms of 35 U.S.C. §103(a) cannot be met. Thus, for this mutually exclusive reason, the Examiner’s burden of factually supporting a *prima facie* case of obviousness clearly cannot be met by the combination of Philipp and Lindquist with respect to claim 19, and the rejection of claim 19 under 35 U.S.C. §103(a) should be withdrawn.

2. The combination of references is improper

Another mutually exclusive and compelling reason why Philipp and Lindquist cannot be applied to reject claim 19 under 35 U.S.C. §103(a) is that neither Philipp nor Lindquist teaches or even suggests the desirability of combination to arrive at the recitation of claim 19 of the present application since neither teaches a nanocrystalline alloy characterized by grains ranging in size from about 10 nm to about 25 nm and consuming between about 70% and about 80% of the nanocrystalline alloy, by volume, wherein the grains are homogeneously dispersed in an amorphous matrix, as specified above and as recited in claim 19. Thus, it is clear that neither reference provides any incentive or motivation supporting the desirability of their combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of claim 19.

In this context, the courts have repeatedly held that, absent some teaching, suggestion or incentive supporting combination, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention. In the present case, it is clear that the Examiner's combination can arise solely from hindsight based on the present application, because there exists no showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 19. Therefore, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met by the combination of Philipp and Lindquist with respect to claim 19, and the rejection of claim 19 under 35 U.S.C. §103(a) should be withdrawn.

Conclusion

It is clear from all of the foregoing that independent claims 1, 14 and 16-19 are in condition for allowance. Dependent claims 2-13, 15 and 20-26 depend from and further limit independent claims 1, 14 and 19 in a patentable sense and, therefore, are allowable as well.

It is believed that all matters set forth in the Office Action have been addressed, and that claims 1-26 are in condition for allowance. Favorable consideration and an early indication of the allowability of the claims are respectfully requested. Should the Examiner deem that an interview with Applicants' undersigned attorney would expedite consideration, the Examiner is invited to call the undersigned attorney at the telephone number indicated below.

Respectfully submitted,



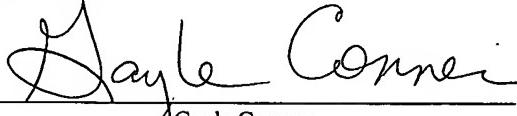
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